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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/626,973	07/25/2003	Ronald D. Blum	63049.001003	3786		
27682	7590	06/17/2004	EXAMINER			
J. MICHAEL MARTINEZ DE ANDINO ESQ. HUNTON & WILLIAMS RIVERFRONT PLAZA, EAST TOWER 951 EAST BYRD ST. RICHMOND, VA 23219-4074				SCHWARTZ, JORDAN MARC		
		ART UNIT		PAPER NUMBER		
				2873		
DATE MAILED: 06/17/2004						

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	Applicant No.	Applicant(s)	
	10/626,973	BLUM ET AL.	
	Examiner	Art Unit	
	Jordan M. Schwartz	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 April 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12, 16-36 and 59-95 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) 1-12, 16-36 and 59-95 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

***Restriction***

Applicant's Election and Amendment dated April 15, 2004 has been received in response to the Restriction requirement dated March 12, 2004. In that Amendment, applicant has cancelled numerous claims, has added new claims 59-95, and has amended many of the previously presented claims. Due to the extensive changes within applicant's Amendment, the previous restriction requirement is no longer valid. However, the Amendment has prompted a new restriction requirement, which is set forth below.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 16, 59-61, 71-85, 89-95, drawn to a spectacle lens or vision correcting lens, classified in class 351, subclass 159.
- II. Claims 17-36, 62-70, 86-88. Claims 17-36 and 62-70 are drawn to an optical system for determining or quantifying error, classified in class 351, subclass 205. Claims 86-88 are being grouped within Group II because they could be searched together with claims 17-27 and 62-66 without creating an undue burden on the examiner.

The inventions are distinct, each from the other because of the following reasons:

Inventions in Group II and Group I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, with respect to claims 1-12, 16,

59-61, 71-85, the combination as claimed does not require the particulars of the subcombination as claimed because the optical system does not require the optic or light altering means to have a peripheral edge capable of being fit into an eyeglass frame or to be a spectacle lens. In the instant case, with respect to claims 89-90, the combination as claimed does not require the particulars of the subcombination as claimed because the optical system does not require the optic or light altering means to have a vision correction region providing at least two regions of different vision correction and with one providing the highest level of vision correction and one providing a lesser level of vision correction. In the instant case, with respect to claims 91-95, the combination as claimed does not require the particulars of the subcombination as claimed because the optical system does not require the optic or light altering means to have a vision correcting area that corrects for an aberration of a wearer's eye based upon wavefront analysis and a region of the lens where the wearer's line of sight transverses the lens being capable of being dynamically altered in its vision correction. The subcombination has separate utility such as a spectacle lens to correct the vision of a wearer's eye, i.e. the spectacle lens does not need to be used in an optical system that either determines the refractive error of a patient's eye or quantifies the refractive error of a human eye.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for the other Group, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention.

Group I, contains the following patentably distinct species: Group Ia, claims 1-12, 59, 71-85 and 89-90 directed to a species of spectacle lens or vision correcting lens wherein a portion of the refractive error correction is based on a lens prescription determined by a wavefront analysis and the vision correction area corrects non-conventional refractive error; Group Ib, claims 16 and 60-61 directed to a species of spectacle lens or vision correcting lens that uses adaptive optics to correct for non-conventional refractive error to provide a wearer with better than 20/20 vision and that does not require refractive error correction based on a lens prescription determined by a wavefront analysis; and Group Ic, claims 91-95 directed to a species of spectacle lens or vision correcting lens wherein a region of the lens where the wearer's line of sight transverses the lens is capable of being dynamically altered in its vision correction.

Group II contains the following patentable distinct species. Group IIa, claims 17-27, 62-66 (and claims 86-88 which can be searched together with claims 17-27 and 62-66 without creating an undue burden on the examiner) directed to a species of optical system comprising a wavefront measuring device and an optic that is adjusted based upon input received from the patient; and Group IIb, claims 28-36 and 67-70 directed to a species of optical system that uses an auto-refractor or wave-front analyzer capable

of determining an aberration of a patient's eye and that quantifies the refractive error of a human eye.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
June 15, 2004